

**REMARKS**

**I.     Introduction**

For the reasons set forth below, Applicants respectfully submit that all pending claims are patentable over the cited prior art references.

**II.    The Rejection Of Claims 42-45, 48-50, 52-55 And 57 Under 35 U.S.C. § 103**

Under 35 U.S.C. § 103(a), claims 42-45, 48-50, 52-55 and 57 were rejected as being unpatentable over Shigehiro et al. (USP No. 6,741,387) in view of O'Mara et al. (USP No. 4,837,249). Applicants respectfully traverse the above cited rejection for at least the following reasons.

With regard to the present invention, claims 42, 44 and 57 each recite, in-part, a display device comprising: a pair of substrates disposed opposite to each other, at least one of which is transparent; a plurality of particles having an electrostatic property contained in a gaseous phase provided between the pair of substrates; first and second electrodes provided for each of pixels arranged in a matrix for driving the particles; and a voltage applying portion for applying voltage to the first and second electrodes in accordance with an image signal, wherein the particles each comprise a parent particle as a core ... and when voltage is applied to the first and second electrodes by the voltage applying portion, the particles are caused to travel between the first and second electrodes in accordance with the voltage applied so as to display an image corresponding to the image signal.

It was alleged in the pending Office Action that the combination of O'Mara and Shigehiro renders claims 42, 44 and 57 of the present invention obvious. Specifically, the Examiner states that "it would have been obvious to one having ordinary skill in the art...to

combine the device of Shigehiro et al. with the parent particles of O'Mara et al. for the purpose of forming a multilayered shell."

The combination of Shigehiro and O'Mara proposed by the Examiner is improper. The particles of O'Mara would not be particularly useful as particles for the use as disclosed in Shigehiro. The device of Shigehiro uses conductive particles, which contain metal cores to form images by moving the charged particles across substrates in a display element. The particles disclosed in O'Mara, which are not charged and do not contain a metal core, would not readily move across substrates as required by Shigehiro due to the properties described above. As is well known in patent law, if a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). As the use of the particles of O'Mara would not obtain the desired result of forming an image in the device of Shigehiro, Applicants respectfully submit that the proposed combination is improper because there is no suggestion or motivation to make the proposed modification.

Furthermore, the Examiner has provided no teaching or suggestion to suggest the desirability to combine the two above cited references. Applicants refer the Examiner to § 2141 of the MPEP entitled, "*Basic Considerations Which Apply to Obviousness Rejections*", part (B) which states, "The references must be considered as a whole and **MUST** suggest the desirability and thus the obviousness of making the combination." Moreover, the Supreme Court recently upheld that a patent composed of several elements is not proved obvious without identifying a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements (*KSR International Co. v. Teleflex Inc.*, 550 U.S. 14-15 (2007)). As stated above, the

particles of O'Mara are unusable with the device of Shigehiro. Thus, there is no reason to combine the two cited prior art references.

In addition, the O'Mara reference relates to the processing of high molecular weight polymers which are readily dissolvable and to uses of these compositions of dissolved polymers (see, O'Mara, col. 1, lines 11-14), whereas Shigehiro is directed to a display element in which the charged particles are used to display an image on a screen (see, Abstract of Shigehiro). As the two references are in completely different technical fields, it would not be readily obvious to combine them. Nor is the invention in O'Mara reasonably pertinent to the particular problem with which Shigehiro is concerned. Thus, without any suggestion to combine the above cited references, which are in non-analogous fields and concern unrelated problems, and in addition to the argument recited above against combining the references, Applicants submit that the requisite motivation to combine Shigehiro and O'Mara to substantiate a rejection under 35 U.S.C. § 103 has not been demonstrated. As such, Applicants submit that the proposed combination is improper.

Accordingly, it is respectfully requested that the § 103 rejection of claims 42, 44, 57, and any pending claims dependent thereon be withdrawn.

**III. All Dependent Claims Are Allowable Because The Independent Claim From Which They Depend Is Allowable**

Under Federal Circuit guidelines, a dependent claim is nonobvious if the independent claim upon which it depends is allowable because all the limitations of the independent claim are contained in the dependent claims, *Hartness International Inc. v. Simplimatic Engineering Co.*, 819 F.2d at 1100, 1108 (Fed. Cir. 1987). Accordingly, as claims 42, 44, and 57 are patentable

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for the reasons set forth above, it is respectfully submitted that all pending dependent claims are also in condition for allowance.

**IV. Conclusion**

Having fully responded to all matters raised in the Office Action, Applicants submit that all claims are in condition for allowance, an indication of which is respectfully solicited.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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